

REMARKS

Claims 1-17 are pending in this application. Claim 1 is the only independent claim. By this amendment, claim 1 is amended to amplify arguments presented throughout prosecution. Reconsideration in view of the above amendments and following remarks is respectfully solicited.

Entry of the amendment is proper under 37 CFR §1.116 since the amendment:

(a) places the application in condition for allowance (for reasons discussed herein); (b) do not raise new issue requiring further search and/or consideration (since the amendment amplify issues previously discussed throughout prosecution); (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and/or (e) places the application in better form for appeal, should an appeal be necessary. Entry of the amendment is thus respectfully requested.

The Claims Define Patentable Subject Matter

The final Office Action rejects: (1) claims 1, 2, 12 and 17 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,475,509 to Okamoto (hereafter Okamoto); (2) claims 3-5 and 7 under 35 U.S.C. §103(a) as being unpatentable over Okamoto in view of U.S. Patent No. 6,188,432 to Ejima (hereafter Ejima); (3) claims 6 and 11 under 35 U.S.C. §103(a) as being unpatentable over Okamoto in view of U.S. Patent No. 4,973,149 to Hutchinson (hereafter Hutchinson); (4) claims 8-9 and 14-15 under 35 U.S.C. §103(a) as being unpatentable over Okamoto in view of Japanese Patent

407074943A to Nakamura; and (5) claims 10, 13 and 16 under 35 U.S.C. §103(a) as being unpatentable over Okamoto in view of Ejima and further in view of Nakamura.

These rejections are respectfully traversed.

Applicant respectfully submits that Okamoto, either alone or in combination with the other cited references, fails to teach or suggest each and every feature as set forth in the claimed invention. In particular, Okamoto at least fails to teach or suggest setting image processing conditions based *primarily* on the at least one principal part of the image designated, as set forth in amended independent claim 1.

Claim 1 recites, *inter alia*, image processing means for performing necessary image processing on the received image data to produce output image data. Display means displays an image carried by the image data supplied from the source of image data supply. Designating means designates at least one principal part of the image displayed by the display means. Setting means sets image processing conditions primarily in accordance with information about the at least one principal part of the image designated. The image processing means performs the necessary image processing under the image processing conditions set by the setting means.

For example, in the claimed invention a setting subsection 66 selects what image processing should be executed and sets the relevant image processing conditions. Prescanned data is read from the prescan memory 40 and processed under the thus set image processing conditions. The processed prescanned data is then displayed on the display 20. Looking at the displayed data, the

operator designates a point in the principal part of the image on the display. The conditions setting section receives information about the region of the principal part and sets image processing conditions or calculates the amount of adjustments from the previously set conditions primarily in accordance with the image data for the designated principal part. In other words, the present invention relies primarily on the designated principal part of the image to make adjustments to the processing conditions.

In contrast to the present invention, Okamoto discloses that first a particular point to be corrected in the image data is specified and finishing requirements are specified. Secondly, Okamoto processes the image data at the specified point under predetermined image processing conditions to obtain processed image data. Lastly, Okamoto compares the processed image data with target processed data to revise the image processing conditions based on the result of the comparison. (see Okamoto, col. 1, lines 50-64). In other words, Okamoto discloses that the image processing conditions are corrected *based on the result of the comparison* made by comparing the processed image data (image data at the specified points under predetermined conditions) with target processed data (data that meets the finishing requirements). Thus, Okamoto sets corrected image processing conditions by using both predetermined processing conditions and inputted finishing requirements, instead of looking primarily at the principal part of the image as set forth in amended claim 1.

Furthermore, Okamoto's image processing conditions are not set by using only the image data of the specified point, but the image processing conditions of the specified point are set wherein the

specified point is first finished so as to adapt to or coincide with finishing requirements. In Okamoto, the image processing conditions of the specified point are set to adapt to the finishing requirements suitable for the specified point which are selected by an operator, however, the processing conditions in Okamoto are not set to be suitable for the contents or scenes of the specified point itself nor set by using primarily the image data of the specified point.

However, in the claimed invention, corrected conditions are set primarily in accordance with information about the principal part of the image designated. In contrast, Okamoto requires that both the process image data and the finishing requirements must be looked at and compared. The additional step of comparing such data in Okamoto also adds to the processing time. In contrast to Okamoto, in the present invention, if an operator designates a principal part, appropriate image processing conditions for that principal part are set by the image data thereof to optimally finish the principal part in accordance with the contents therein, for example, in accordance with whether the principal part is a face of a person or a landscape which is other than the face of the person. (see applicant's specification, page 28, line 17 to page 30, line 6). Thus, in the present invention, optimal image processing conditions are primarily set in accordance with the contents in an image scene, i.e., the contents in an image scene determined by the principal part. (see applicant's specification, page 5, line 2 from the bottom to Page 6, line 3).

In contrast to Okamoto, in the present invention appropriate image processing conditions are automatically set primarily in accordance with at least one principal part of the image designated by an operator who only specifies at least one principal part of the image displayed by the display means with the specifying means. However, in Okamoto what is automatically set based on fuzzy inference rules is the part of the image processing conditions that are set by the image data of the entire image, before setting the image processing conditions of a designated specified position, but not the image processing conditions of the specified point suitable for selected finishing requirements.

In addition, in Okamoto, although the image data of the designated specified point may be first processed using the part of the image processing conditions automatically set based on fuzzy inference rules, the processed image data is then compared to the target processed data that satisfy the finishing requirements and then the image processing conditions are corrected according to the result of the comparison. Thus, in Okamoto the image data of the designated specified point is only processed by predetermined image processing conditions to obtain the processed image data. (see Okamoto, claim 1 and step 33 of Fig. 6).

In Okamoto, the image processing conditions of the specified point are set based on the result of the comparison between the processed image data and the target image data, instead of being based primarily on the image data itself of the specified point, as set forth in the present claim 1.

According to MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either

expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claims, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicant respectfully submits that the Office Action has failed to establish the required *prima facie* case of anticipation because the cited reference, Okamoto, fails to teach or suggest each and every feature as set forth in the claimed invention.

Additionally, applicant notes that, in order to anticipate a "means-plus-function" clause as recited in independent claim 1, a reference must disclose a function identical to the recited function. Applicant respectfully submits that the final Office Action is merely using portions of the claimed functions and is attempting to find the same function in the cited reference. However, the entire identical function must be disclosed.

Applicant respectfully submits that independent claim 1 is allowable over Okamoto for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claim, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1, 2, 12 and 17 under 35 U.S.C. §102(b) is respectfully solicited.

Applicant also respectfully submits that Ejima, Hutchinson and Nakamura all fail to make up for the deficiencies found in Okamoto.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Like Okamoto, Ejima, Hutchinson and Nakamura all fail to teach or suggest setting corrected image processing conditions primarily based on the information about the at least one principal part of the image designated, as set forth in amended claim 1.

As such, applicant respectfully submits that the combination of Okamoto with either Ejima, Hutchinson and/or Nakamura fails to teach or suggest each and every feature as set forth in the claimed invention.

Applicant also respectfully submits that not only does the combination of references fail to teach or suggest each and every feature as set forth in the claimed invention, but that one of ordinary skill in the art would not have been motivated to combine/modify the teachings of Okamoto with the other cited references because there is no teaching or suggestion in any of the

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references regarding how or why one would modify such systems to arrive at the claimed invention.

Applicant respectfully submits that dependent claims 3-11 and 13-16 are all allowable over Okamoto in combination with either Ejima and/or Hutchinson and/or Nakamura for at least the reasons noted above.

Accordingly, withdrawal of the rejection of claims 3-11 and 13-16 under 35 U.S.C. §103(a) is respectfully solicited.

Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Applicant respectfully petitions under the provisions of 37 C.F.R. §1.136(a) and §1.17 for an one (1) month extension of time in which to respond to the Examiner's Office Action. The appropriate Extension of Time Fee is attached hereto.

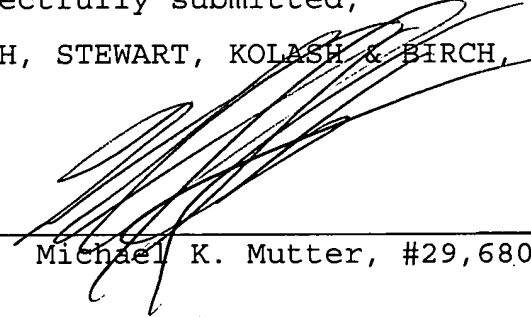
Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 to schedule a Personal Interview.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Respectfully submitted,
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By


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